

REMARKS

STATUS OF THE CLAIMS

Claims 24, 27-33, 35-39, 41-43, 48-50 and 71 were pending as shown in the paper filed with the request for continued examination (RCE), filed on August 5, 2005. Pursuant to a Restriction Requirement (discussed below) that has now been made FINAL, claims 30, 31 and 43 have been withdrawn from consideration.

By virtue of this Response, claims 24, 27, 28, 29 and 32 have been amended as shown above to eliminate parenthesis and refer to amino acids sequences by sequence identifier or by their position in this sequence identifier.

Accordingly, claims 24, 27-33, 35-39, 41-43, 48-50 and 71 are pending as shown above and claims 24, 26-29, 32, 33, 35-39, 41, 42, 48-50 and 71 are under consideration.

PRIORITY

Applicants note that the Office has acknowledged receipt on September 29, 2005 of a certified copy of U.K. priority application 0001578.4.

35 U.S.C. § 112, 1ST PARAGRAPH , WRITTEN DESCRIPTION, NEW MATTER

Claim 24 was rejected under 35 U.S.C. § 112, 1st paragraph as allegedly not described by the specification as filed. (Office Action, pages 3-4). This new matter rejection was based on the allegation that the specification does not describe “at least one” with respect to the number of binding motifs of the zinc finger that have been engineered. *Id.* In addition, the phrase “under conditions” was alleged not be supported.

With regard to the rejection of “under conditions,” Applicants note that this phrase does not appear in the claims. Thus, this rejection may be withdrawn.

Turning to the rejection of claim 24 for reciting “at least one,” Applicants note that the proscription against the introduction of new matter in a patent application (35 U.S.C. § 132) serves to prevent an applicant from adding information that goes beyond the subject matter

originally filed. *See, e.g., In re Rasmussen*, 650 F.2d 1212, 1214, 211 USPQ 323, 326 (CCPA 1981) and MPEP § 2163.06. Further, literal support is not required (M.P.E.P. § 2163):

The subject matter of the claim need not be described literally (*i.e.*, using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement.

Thus, the written description requirement is satisfied if the specification reasonably conveys possession of the invention to one skilled in the art. *See, e.g., In re Lukach*, 169 USPQ 795, 796 (CCPA 1971). The disclosure must be read in light of the knowledge possessed by the skilled artisan at the time of filing, for example as established by reference to patents and publications available to the public prior to the filing date of the application. *See, e.g., In re Lange*, 209 USPQ 288 (CCPA 1981). Moreover, the burden is on the Examiner to provide evidence as to why a skilled artisan would not have recognized that the applicant was in possession of claimed invention at the time of filing. *Vas-Cath, Inc. v. Mahurkar*, 19 USPQ2d 1111 (Fed. Cir. 1991); *In re Wertheim*, 191 USPQ 90 (CCPA 1976).

In the pending case, the as-filed specification clearly conveys that Applicants were in possession of zinc finger polypeptides comprising at least two zinc fingers and wherein at least one of the zinc fingers is engineered. Indeed, on page 4, line 22 to page 5, line 3 of the specification, Applicants indicate that a single zinc finger may be engineered. Furthermore, the as-filed specification clearly indicates that at least one of the claimed zinc finger proteins (which may include one or more zinc fingers) are preferably engineered. *See, e.g.*, page 9, line 18-19. In addition, Applicants note that the Examples describe multi-fingered zinc finger polypeptides in which some of the individual zinc fingers have not been engineered.

In view of this clear disclosure (and exemplification) along with the failure of the Office to provide evidence as to why the skilled artisan would not have understood that Applicants were in possession of the subject matter of claim 24, withdrawal of this rejection is respectfully requested.

35 U.S.C. § 112, 2ND PARAGRAPH

Claims 24 (and claims dependent thereon) as well as claim 27 were rejected under 35 U.S.C. § 112, 2nd paragraph as allegedly indefinite for their use of parentheses. (Office Action, pages 4-5).

For the reasons of record, Applicants submit that placement of sequence identifiers in parentheses following the sequence itself is standard practice and not confusing. Nonetheless, Claims 24 and 27 has been amended to remove the parenthesis surrounding the sequence identifiers as well as the sequence information which is contained in SEQ ID NO:22, thereby removing any confusion about what is claimed. Thus, the rejection may be withdrawn.

35 U.S.C. § 102

Claims 24, 27-28, 32-33, 35-37, 39, 41-42 and 49-50 were rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent No. 6,534,261 (hereinafter "Cox"). *See, e.g.*, page 5 of the Office Action, citing the VEGF1 and VEGF3a zinc finger proteins disclosed at cols 41, line 5 through column 42, line 9 of Cox.

In response, Applicants note that the proteins disclosed by Cox were designed to bind to the human vascular endothelial growth factor (VEGF) gene. By contrast, the pending claims are drawn to plant cells. Since plants do not have VEGF genes, the two proteins were designed by Cox to regulate expression of a human VEGF gene, Cox fails to disclose plant cells comprising the claimed molecules. Accordingly, U.S. Patent No. 6,534,261 fails to anticipate the claimed subject matter and Applicants respectfully request withdrawal of the rejection.

35 U.S.C. § 103

Claim 48 was rejected under 35 U.S.C. § 103(a) as allegedly obvious over Cox in view of Kim and Puchta. (Office Action, pages 5-7).

As noted above, Cox does not describe or demonstrate plant transgenic cells comprising the claimed proteins. Rather, the proteins disclosed in Cox regulate human VEGF. Accordingly, there is no combination of Cox, Kim and Puchta that renders claim 38 obvious and withdrawal of this rejection is in order.

CONCLUSION

In view of the foregoing amendments, Applicants submit that the claims are now in condition for allowance and request early notification to that effect.

Respectfully submitted,

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